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ProPat LLC  
2912 CROSBY ROAD  
Charlotte, NC 28211

EXAMINER

NGUYEN, KIMBERLY T

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6

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/779,156	<b>Applicant(s)</b> MURSCHALL ET AL.	
	<b>Examiner</b> Kimberly T. Nguyen	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
- 1. ☐ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3 and 4</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to an opaque white film, classified in class 428, subclass 212.
- II. Claims 12-15, drawn to a process for producing an opaque white film, classified in class 264, subclass 171.11.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as mixing the thermoplastic material and optical brightener and then providing pressure to the mixture to produce a film.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Klaus Schweitzer on May 6, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and <sup>→ withdrawn</sup>10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear what Applicants claim since claim 1 shows the phrase "whose principle constituent is a crystallizable thermoplastic" *preceding* the transition phrase of "the film comprises..." Thus, the scope of the claim is unclear. ✓

In claim 1, the phrase "at least barium sulfate" is not clear. ✓

The term "principal" in the phrase "whose principal constituent is a...thermoplastic" in claim 1 is a relative term which renders the claim indefinite. The term "principal" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, ✓

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and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claims 7 and 8, it is not clear why the step of "gloss... measured to DIN 67530," "measured by the Sedigraph method," and "measured to ASTM-D 1003" is included in the product claims since no method is claimed. Further, such process limitations are given no patentable weight in product claims. X

The terms "uniform" and "streak-free" in claim 8 relative terms which render the claim indefinite. The terms "uniform" and "streak-free" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. ✓

Claim 9 recites the limitation "the form" in lines 18-19. There is insufficient antecedent basis for this limitation in the claim. ✓

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5 and 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al., U.S. Pat. No. 5,660,931.

Kim shows a white film (base layer) comprising polyethylene terephthalate (crystallizable thermoplastic), barium sulfate (column 2, lines 3-9), and bisbenzoazole (optical brightener) (column 5, lines 13-22). Kim shows that the white film has a thickness of 12

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micrometers (column 9, lines 11-16). Kim shows that the rutile-type titanium dioxide has an average particle diameter ranging from 0.1 to 3 micrometers (column 2, lines 54-55). Kim shows that the degree of whiteness of the film is greater than 85% (Table 2). Kim shows that the film may comprise additives (column 6, lines 59-65).

Though Kim shows that the bisbenzoazole is added in an amount so that the reflectivity at 440 nm becomes greater than 75% (column 5, lines 21-22), Kim does not show that the bisbenzoazole is 10-50,000 ppm of the weight of the crystallizable thermoplastic as in instant claim 4. Kim does not show the percentage by weight as in instant claims 3, 7, and 11. Kim does not show the thickness as in instant claim 10. However, such concentrations, percentages by weight, and thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the concentrations, percentages by weight, and thicknesses, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. concentrations, percentages by weight, thicknesses) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result effective as they control the amount of light transmitted, transparency, and reflectiveness of the film. As such, they are optimizable.

While Kim shows that polyethylene glycol is provided to impart an improved anti-static and printability functionality to the surface of the film (surface coating), Kim does not specifically show a separate coating to impart a functionality as in instant claim 1. The invention of Kim already has the desired functionality of, for example, printability and antistatic properties,

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which Applicants attempt to achieve by a separate coating. However, the mere duplication of parts (i.e. functional layer) has no patentable significance unless a new and unexpected result is produced.

Kim does not show that the white film is opaque as in instant claims 1-5 and 9-10; however, the relative level of opacity is a property which can be easily determined by one of ordinary skill in the art by adjusting the concentration of the white pigments and thicknesses. Opacity is a result effective parameter and thus, is optimizable. With regard to the limitation of the opacity, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. opacity) fails to render claims patentable in the absence of unexpected results.

Claims 1, 3, 4, and 10 are also rejected because they are product-by-process claims. Additionally, the phrases "where the barium sulfate or the optical brightener...is either incorporated directly into...or fed as a masterbatch during film production" and in claim 10, "coating has been applied as..." introduces process limitations to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

**Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al., U.S. Pat. No. 5,660,931 in further in view of von Meer, U.S. Pat. No. 4,384,040.

Kim is relied upon as above for claim 1.

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Kim does not show the blue dye and amount of blue dye as in instant claim 6.

However, the amount of blue dye is a property which can be easily determined by one of ordinary skill in the art in order to enhance the whiteness of the film. With regard to the limitation of the amount of blue dye, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. Since the blue dye directly affects the whiteness of the film, it is an optimizable feature. The experimental modification of prior art in order to optimize operation conditions (e.g. amount of blue dye) fails to render claims patentable in the absence of unexpected results.

Von Meer shows a photographic paper wherein the white titanium dioxide pigmented paper is dyed with cobalt blue or ultramarine (column 3, line 68 to column 4, line 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to cobalt blue or ultramarine in addition to the whitening titanium dioxide because it is known that cobalt blue and ultramarine is used to enhance the whiteness and to compensate for the yellowish tint of the invention.

Kim does not show that the white film is opaque as in instant claim 6; however, the level of opacity is a property which can be easily determined by one of ordinary skill in the art by adjusting the concentration of the white pigments and thicknesses. Opacity is a result effective parameter and thus, is optimizable. Opacity is a result effective parameter and thus, is optimizable. With regard to the limitation of the opacity, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize



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operation conditions (e.g. opacity) fails to render claims patentable in the absence of unexpected results.

**Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al., U.S. Pat. No. 5,660,931 in further in view of Yamazaki, U.S. Pat. No. 6,106,924.

Kim is relied upon as above for claim 1. Kim further shows that the average diameter for the barium sulfate particles is from 0.1 to 0.5 micrometers (column 5, lines 10-12).

Kim does not specifically show that the barium sulfate is in the form of fine-particle powder or that it is colorless as in instant claim 7. However, since the average diameter for the barium sulfate particles is from 0.1 to 0.5 micrometers, it would be known to one of ordinary skill that a particle having this diameter is in fine-particle powder form. Further, barium sulfate is known to be white, which also means colorless.

Kim does not show that the barium sulfate is precipitated as in instant claim 7.

Yamazaki shows a polyethylene laminate material comprising precipitated barium sulfate (column 4, lines 44-49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to precipitated barium sulfate in the invention of Kim since it is known in the art that precipitated barium sulfate is effectively used for imparting whiteness to polyethylene laminates.

Kim does not show that the white film is opaque as in instant claim 7; however, the opacity of a film is a property which can be easily determined by one of ordinary skill in the art by adjusting the concentration of the white pigments and thicknesses. Opacity is a result effective parameter and is thus, optimizable. With regard to the limitation of the opacity, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because

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they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. opacity) fails to render claims patentable in the absence of unexpected results.

**Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al., U.S. Pat. No. 5,660,931.

Kim is relied upon as above for claim 1. Though Kim shows percentages of surface gloss in Table 3 and transmittance in Table 2, Kim does not specifically show the surface gloss and luminous transmittance as instant claim 8. However, such values are properties which can be easily determined by one of ordinary skill in the art. The surface gloss and luminous transmittance are result effective parameters and thus, are optimizable. With regard to the limitation of the surface gloss and transmittance, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. surface gloss and transmittance) fails to render claims patentable in the absence of unexpected results.

Kim does not show that the white film is opaque as in instant claim 8; however, the opacity of a film is a property which can be easily determined by one of ordinary skill in the art by adjusting the concentration of the white pigments and thicknesses. Opacity is a result effective parameter and thus, is optimizable. With regard to the limitation of the opacity, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art

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in order to optimize operation conditions (e.g. opacity) fails to render claims patentable in the absence of unexpected results.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176.

The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

